



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,338	06/07/2000	John G. Rohrbaugh	10003687-1	8717

22878 7590 04/08/2003

AGILENT TECHNOLOGIES, INC.
INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT.
P.O. BOX 7599
M/S DL429
LOVELAND, CO 80537-0599

EXAMINER

TORRES, JOSEPH D

ART UNIT	PAPER NUMBER
----------	--------------

2133

DATE MAILED: 04/08/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,338

Applicant(s)

ROHRBAUGH ET AL.

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The Applicant defines a "test sequence" as a series of test vectors in lines 6-7 on page 3 of the Applicant's specification. Hence, a test sequence is a set consisting of test vectors by that definition. In the Applicant's summary (e.g., see lines 1-2 on page 7 of the Applicant's specification), the applicant cites, "each test sequence of the set of test sequences containing a plurality of bits" which contradicts the definition of test sequence that the Applicant has provided since bits are not test vectors.

Appropriate correction is required to clarify the invention.

2. The abstract of the disclosure is objected to because it cites, "each test sequence of the set of test sequences containing a plurality of bits" which contradicts the definition of test sequence that the Applicant has provided in lines 6-7 on page 3 of the Applicant's specification. Correction is required. See MPEP § 608.01(b).

Response to Arguments

3. Applicant's arguments with respect to previously examined claims 1-20 filed March 13, 2003 have been fully considered but they are not persuasive.

Art Unit: 2133

The Applicant contends, "As mentioned above, Applicants assert that no contradiction exists and that p. 3, lines 4-12 adequately define the test sequence as inherently containing a plurality of bits. Therefore, the claims are believed to be free of contradiction and clear to one skilled in the art. Applicants respectfully request that the rejection of claims 1-20 be withdrawn in light of the definition of terms presented in p. 3, lines 4-12". Lines 4-12 on page 3 explicitly cites, "a test sequence is a series of test vectors, hence a test sequence consists of a sequence of elements called test vectors". By that very definition a sequence is not even a set, hence it is not even clear what could be meant by a sequence containing elements, that is, sets contain elements sequences consist of elements. Furthermore a test vector is a sequence of test data usually bit pattern data, hence a test vector consists of a sequence test data or bit patterns hence a test vector is not a set and does not contain any elements. Because of this it is unclear from the language in the claim whether the Applicant is referring to the test sequence taught on page 3, that is, a test sequence consisting of a series of test vectors which in turn consist of test data or bit patterns, or whether the Applicant is trying to claim some entirely different structure.

The Applicant contends, "As mentioned above, p. 3, lines 4-12 of the specification define a "test vector" as a string of logic bits having values of 0, 1, or X (don't care; 0 or 1) and a "test sequence" as a series of test vectors. Hence, a test sequence contains a plurality of bits". By that very definition a test sequence is not even a set. A set is not

Art Unit: 2133

series or a sequence. Furthermore, the test sequence consists of a series of test vectors by the definition on page 3, line 4-12 and not bits.

The problem that the Examiner or that one of one skilled in the art to which it pertains, or with which it is most nearly connected, has in making and/or using the invention or even determining the scope and bounds of the claim is that it is not clear whether the Applicant is using test sequence to mean test vector in the claim or whether the test sequence in the claim has anything to do with the test vectors and test sequences taught in the application and it is unclear what structure the test sequence as recited in the Applicant's claim 1 refers to.

The Examiner disagrees with the applicant and maintains all rejections of previously examined claims 1-20. All amendments and arguments by the applicant have been considered. The rejection of previously examined claims 1-20 is maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

Art Unit: 2133

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

See Paper No. 5 for detailed action of prior rejections.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

See Paper No. 5 for detailed action of prior rejections.

6. The Examiner would like to point out that claims 1-20 are replete with 35 U.S.C. 112 and it is not clear what the phrase "test sequence" refers to whether the Applicant intends "test vector " in place of test sequence, whether the Applicant intends "test vectors" in place of "bits" or whether the applicant has inadvertently left out key essential elements relating a plurality of bits to a "test sequence" as defined by the Applicant in lines 6-7 on page 3 of the Applicant's specification. The Applicant needs to correct all 35 U.S.C. 112 issues in claims 1-20 and, at this point in time, the Examiner is unable to examine the claims on merits to determine patentability.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (703) 308-7066. The examiner can normally be reached on M-F 8-5.

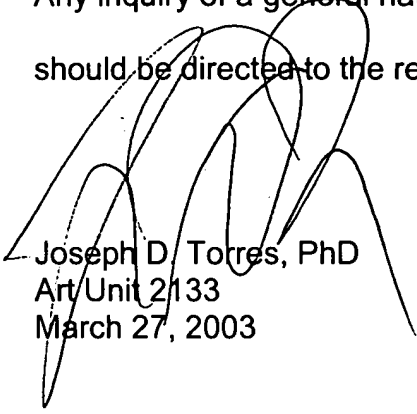
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Application/Control Number: 09/589,338

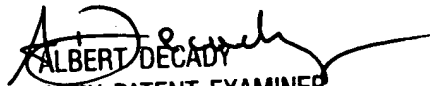
Page 7

Art Unit: 2133

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-746-7240.



Joseph D. Torres, PhD
Art Unit 2133
March 27, 2003



ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100